

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 21-40 are pending in this application. By this amendment, claims 21 and 39 are amended. No new matter is added. Claims 21 and 39 are the independent claims.

Entry of After Final Rejection

Applicants submit that this Amendment After Final Rejection places this application in condition for allowance by amending claims in manners that are believed to render all pending claims allowable over the cited art and/or at least place this application in better form for appeal. This Amendment is necessary to clarify the invention and was not earlier presented because Applicants believed that the prior response(s) placed this application in condition for allowance, for at least the reasons discussed in those responses. Accordingly, entry of the present Amendment, as an earnest attempt to advance prosecution and/or to reduce the number of issues, is requested under 37 C.F.R. §1.116.

Applicants' Initiated Interview Summary

The courtesies extended by Examiner Vaughan to Applicants' representative, David J. Cho, Reg. No. 48,078, during a telephonic interview conducted on February 17, 2010, are acknowledged and appreciated. The substance of the interview is set forth in the Examiner's Interview Summary and in the following Applicants Initiated Interview Summary.

As required by 37 C.F.R. § 1.133(b), Applicants' summary of that interview is as follows:

1. Brief Description of any Exhibit Shown

No exhibit was shown or demonstrated during the interview.

2. Identification of the Claims Discussed

The Examiner and Applicants' representative discussed independent claims 1, and 39.

3. Identification of the Specific Prior Art Discussed

The Examiner and Applicants' representative discussed U.S. Patent No. 6,711,262 to Vatanen ("the Vatanen reference").

4. Identification of the Proposed Amendments

An amendment was proposed during the interview to distinguish over the Vatanen reference.

5. Summary of the Arguments Presented to the Examiner

Applicants' representative presented arguments regarding the failure of the Vatanen reference to disclose the subject matter of independent claim 1. More specifically, Applicants' representative argued that the Vatanen reference fails to disclose or suggest, *inter alia*, "selectively activating or deactivating, by the security module, at least one resource as data or functions of said security module....wherein the resources as data or functions of the security module used by the main application are left active for connection of the equipment to the network so as to obtain the cryptogram from the control server," as recited in claim 21.. Examiner Vaughan asserted that the Vatanen reference, as broadly interpreted, teaches the above-mentioned feature.

Applicants' representative then presented further claim amendments as made in the instant amendment to distinguish over the applied reference of Vatanen. Specifically, Applicants' representation argued that the applications are installed in the equipment, and that the method of Vatanen reference applies to a configuration where the applications are stored in the SIM; instead of the applications being stored in the equipment which uses the resources stored in the SIM. The Examiner agreed with the proposed amendment, and suggested Applicants to file a response so that he may fully and formally consider the amendment.

6. General Indication of Other Pertinent Matters Discussed

No other pertinent matters were discussed during the interview.

7. General Outcome of the Interview

The Examiner and Applicants' representative agreed on the nature of the subject matter recited in independent claim 1. The Examiner also indicated that further searching will be required, and if no art is found, the Examiner will place the application in condition for allowance.

Claim Rejections - 35 U.S.C. § 103

Claims 21-26 and 38-40 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,864,757 to Parker et al. ("the Parker reference") in view of U.S. Patent No. 6,711,262 to Vatanen ("the Vatanen reference"). Applicants respectfully traverse this rejection for the reasons detailed below.

As discussed and agree by the Examiner during the February 17, 2010 interview, Applicants respectfully submit that the Parker and the Vatanen references, individually or in combination, fail to disclose, or even suggest, *inter alia*:

receiving and analyzing the cryptogram by the security module **for acting on specific applications according to instructions included in the cryptogram**, and

selectively activating or deactivating **at least one resource as data or functions stored in said security module** by executing instructions included in the cryptogram and using the selected resource to condition the functioning of the **at least one additional application stored in the equipment** according to criteria established by at least one of a supplier of said additional application, the operator and a user of the equipment,

as recited in amended claim 21.

As previously discussed, the Parker reference includes only one application having the main feature of a "calling function." This application may be one of three statuses, e.g., as unlocked, locked and limited to emergency calls, according to commands sent by the control server. Accordingly, the use of resources as data or functions of the security module managing the main application as well the additional application is not mentioned or taught by the Parker reference. Moreover, the operations of selectively activating or deactivating security module resources of specific additional applications according to instructions of the cryptogram without disabling the main application resources necessary for connection of the terminal to the network are not disclosed by the Parker reference. Therefore, the Parker reference fails to disclose or suggest, *inter alia*, "selectively activating or deactivating at least one resource as data or functions stored in said security module by executing instructions included in the cryptogram and using the selected resource to condition the functioning of the at least one additional application stored in the equipment," as recited in amended claim 21.

In regard to the Vatanen reference¹, this reference merely relates to a method of controlling applications stored in a subscriber identity module attached to a mobile terminal. A key list comprising one or more application specific keys is stored in the subscriber identity module. The key list is preferably linked or connected with the subscriber identity module by using a unique identifier associated with that subscriber identity module. A corresponding list is also stored in the application control server and the application stored in the subscriber identity module is activated and/or closed using the key list.

Moreover, according to Vatanen, the applications are stored in the SIM (see, *e.g.*, col. 2, lines 23-29), while claim 21 teaches that the SIM stores the resources as data or functions used by applications installed in the terminal. Also no key list is needed as well in the SIM as in the control server. The method of claim 21 may send cryptograms or tokens by the control server directly to the SIM for acting on specific application resources according to instructions included in the token. The instructions may be defined from results of the verification of identification data sent by the terminal at connection to the network for example. Thus, the server does not need to store any key list because the instructions are built in accordance with verification results following an identification request coming from the terminal. The instructions are thus not predefined in a list but vary with parameters and status of the applications recorded in a subscriber details database of the control server.

¹ To be thorough, further expedite prosecution, and for the sake of clarity, Applicants provide discussions of each of the references separately, however, Applicants are not attacking these references individually, but arguing that the references, even taken in combination, fail to render the claimed invention obvious because all features of claim 21 are not found in the prior art.

Therefore, the method of Vatanen applies to a configuration where the applications are stored in the SIM, while the method of claim 21 applies to configuration where the applications may be stored in the terminal and may use resources stored in the SIM.

Accordingly, Applicants respectfully submit that the Parker and the Vatanen references fail to disclose, or even suggest, *inter alia*, "selectively activating or deactivating at least one resource as data or functions stored in said security module by executing instructions included in the cryptogram and using the selected resource to condition the functioning of the at least one additional application stored in the equipment according to criteria established by at least one of a supplier of said additional application, the operator and a user of the equipment," as recited in amended claim 21.

Since the rejection fails to disclose or suggest each and every element of the rejected claims, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 21.

Further, Applicants respectfully submit that the Examiner failed to set forth a *prima facie* case of obviousness with respect to claim 21 because there is no reasonable expectation of success in combining the references and that the proposed combination of the Parker and the Vatanen references is unworkable.

In particular, Applicants note that the Parker's method includes a single application switchable to one of three possible states (i.e., as unlocked, locked and limited to emergency calls) and the Vatanen's method requires a particular configuration where the applications are stored in the SIM along with a key list does not give, in an obvious way, the method of claim 21. Accordingly, Applicants respectfully submit that one of ordinary skill in the art would not have a reasonable expectation of success in

modifying the method of the Parker reference which includes only one application to the method of Vatanen which requires the applications to be stored in the SIM. Therefore, Applicants submit that the Examiner failed to set forth a *prima facie* case of obviousness with respect to claim 21.

In view of the above, Applicants respectfully submit that one of ordinary skill in the art would not have combined the teachings of the Parker and the Vatanen references in the manner used to reject the claims, and that the proposed combination of the Parker and the Vatanen references fails to teach or suggest all of the elements of amended claim 21. Thus, no *prima facie* case of obviousness has been established. Accordingly, claim 21 is allowable over the Parker and the Vatanen references. Dependent claims 21-26 and 38 depend from claim 21 and are allowable for at least the reasons that claim 21 is allowable.

Further, independent claim 39, as amended, directed to the apparatus, recites, *inter alia*:

a device for selectively activating or deactivating at least one resource as data or functions stored in the security module by executing instructions included in the cryptogram and using the selected resource to condition the functioning of the at least one additional application stored in the equipment according to criteria [established by at least one of the supplier of said additional application, the operator and a user of the equipment.

Thus, Applicants respectfully submit that independent claim 39 is allowable for at least similar reasons as discussed above regarding independent claim 21.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Claim 37 is rejected under 35 U.S.C. § 103 as being unpatentable over Vatanen as applied to claim 1 and in further view of U.S. Patent Application Publication No. 2003/0041125 ("the Solomon reference"). Applicants respectfully traverse this rejection for the reasons detailed below.

Claim 37 is believed to be allowable for at least the reasons set forth above regarding claim 21. The Solomon reference fails to provide the teachings noted above as missing from the Parker reference. Since claim 37 is patentable at least by virtue of its dependency on claim 21, Applicants respectfully request that the rejection of claim 37 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

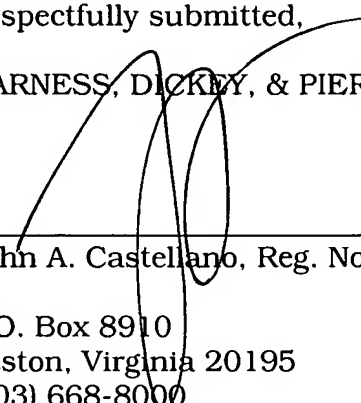
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By



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